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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/892,859      | 06/28/2001  | Ichiro Nakano        | Q65181              | 3129             |

7590 10/03/2002  
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

BISSETT, MELANIE D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1711

DATE MAILED: 10/03/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 6

**Office Action Summary**

Application No.

09/892,859

Applicant(s)

NAKANO ET AL.

Examiner

Melanie D. Bissett

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Summary of the Claims***

1. Claim 1 is drawn to a cover tape comprising a substrate, either a base coating layer or an intermediate layer on the substrate, an adhesive layer on the base or intermediate coating, and a conductive layer on either the rear surface of the substrate or the front surface of the adhesive. Claim 11 is drawn to an electric-part-conveying member comprising an electronic-part-storage member and a cover tape, where the cover tape is as described above. Claims 2-3 limit the conductive layer, claim 4 limits the adhesive layer, claim 5 limits the base coating layer, claim 6 limits the intermediate layer, claims 7-9 limit properties of the cover tape, and claim 10 limits the melting point of the substrate.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5-8, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Dai Nippon. Dai Nippon (EP 0836936 A1) can be found on the applicant's Form PTO-1449.

4. Dai Nippon discloses a laminated structure having a heat sealant layer and an antistatic layer, which may be adhered to a container for electric devices (abstract; p. 2

lines 5-9). A preferred embodiment teaches a laminate comprising a base layer, an adhesive layer, an intermediate layer, a heat sealant layer, and an antistatic layer, in order (p. 3 lines 28-40). The adhesive layer (teaching a base layer of the present invention) can comprise a urethane resin (p. 4 lines 55-57) and has a thickness of 0.5-80  $\mu\text{m}$ . The heat sealant layer is an adhesive layer that may be hot-melt or pressure-sensitive adhesive (p. 6 lines 13-18; p. 10 lines 28-29). The antistatic layer is deposited on the heat sealant layer and contains a semiconductor as a principal component, where the antistatic layer can be as thin as 0.01  $\mu\text{m}$  (p. 11 lines 27-35) and has a surface resistivity of  $10^5$ - $10^{12} \Omega/\square$  (p. 17 lines 34-35). Materials for the substrate resin film include PET, PEN, nylon, and polyolefins, all cited by the applicant as substrate materials; the reference notes several substrate materials having melting points higher than 90 °C. A preferred intermediate layer contains polyolefin materials (p. 18 lines 7-15). All working examples show light transmissivities above 60% (Tables 1-5 and 1-7).

5. In another preferred embodiment, an antistatic layer is applied to the rear surface of the substrate, where antistatic agents in the layer include copper, iron, aluminum, nickel or gold metal particles (p. 22 lines 23-35). The surface resistivity of this antistatic layer is also  $10^5$ - $10^{12} \Omega/\square$  (p. 22 lines 54-56).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 9 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dai Nippon.

8. Dai Nippon applies as above, failing to mention the frictional electrification voltage properties of the adhesive layer side of the cover tape. It is the examiner's position that, because the reference discloses all the limitations of the claims except the frictional electrification voltage properties of the adhesive layer side of the cover tape, the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render the claimed invention obvious. Therefore, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Fitzgerald et al.*, 205 USPQ 594.

9. It is thought that the frictional electrification voltage properties would relate to the antistatic properties of the film. Because the reference teaches methods of reducing static to form surfaces having the same surface resistivity properties as those claimed by the applicant, it is the examiner's position that the adhesive surface would also inherently possess the applicant's frictional electrification voltage properties. Also, since the reference teaches a variety of materials and layer structures to optimize antistatic properties, it is the examiner's position that it would have been prima facie obvious to form a cover tape having a frictional electrification voltage of less than 3,000 V to further optimize antistatic properties of the film.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dai Nippon in view of *Encyclopedia of Polymer Science and Engineering*.

11. Dai Nippon applies as above, noting the use of several pressure sensitive adhesive (PSA) materials but failing to mention the inclusion of a base polymer and a tackifier in specific amounts. *Encyclopedia of Polymer Science and Engineering* teaches that all rubber-based adhesives require tackifiers to impart stickiness (p. 347). Rubber-based adhesives comprise 60-110 parts per 100 parts of elastomer, while acrylic PSAs do not require as much. Since Dai Nippon suggests the use of rubber- and acrylic-based PSAs, it is the examiner's position that it would have been prima facie obvious to include a tackifier in the base resins in any amount necessary to optimize the tack of the adhesive.

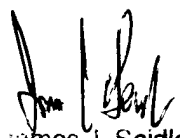
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb  
September 26, 2002



James J. Seidlock  
Supervisory Patent Examiner  
Technology Center 1700